

REMARKS

Claims 1-13 are pending.

§ 102 Rejections

Claims 1-8, 10-13 stand rejected under 35 USC § 102(g) based upon claims 1-4, 6-8 of Rollat et al. (Patent No. 6,689,346).

With respect to the rejection under 35 USC § 102(g), the claims had been amended to recite the subject matter of claim 9, which was not previously under rejection in a prior office action (Feb. 2, 2007). The claims were redrafted in the prior response to include the limitations of this previous dependent claim 9, reciting instead of a composition a cosmetic or personal care article selected from the group consisting essentially of mascara, foundation, rouge, face powder, eye liner, eyeshadow, lipstick, insect repellent, nail polish, skin moisturizer, skin cream, body lotion, and sunscreen.

It would appear that the limitation of claim 1, that it is a cosmetic or personal care article selected from the group consisting essentially of mascara, foundation, rouge, face powder, eye liner, eyeshadow, lipstick, insect repellent, nail polish, skin moisturizer, skin cream, body lotion, and sunscreen, is now being characterized as merely reciting an “intended end use”. However this claim limitation is not a passing intended end use in the claim preamble. Rather the claimed cosmetic products are the class or products that the patent application specification was intended to define and protect. The cosmetic product defined in the Rollat et al patent is a cosmetic product that applicants specifically defined as excluded in the patent as originally filed (page 4 lines 25-27). The closed end language of Claim 1 as drafted functions to effect this exclusion of the reshapable hair care cosmetic products of Rollat et al.

The office action alleges that a body lotion could be used as a reshapable hair care cosmetic product as claimed in Rollat et al. However a body lotion is not a reshapable hair styling composition and applicants specification makes that very clear (page 4 lines 25-27), these are different cosmetic products would need to be formulated and delivered differently to produce

the desired cosmetic product. This is implicit in applicant's claim 1, which is not claiming a specific copolymer but a composition that provides the claimed cosmetic articles. Example 20 of applicant's specification gives a typical example of a body lotion formation required to provide a cosmetic product of this nature. Applicants example 20 body lotion formation would not function as a hair shaping composition, such as are described in Rollat et al's example 22, and vice versa.

The following is a quotation from *Rowe v. Dror* Fed Cir (case No 96-1304) by Judge Rader dealing with when statements in a claim are mere statements of use verses limitations that define the end product. Applicant's language is designed and intended to structurally limit the claimed subject matter to something other than what is disclosed in Roulett and applicants specification, the "patent as a whole", makes this abundantly clear. The alleged "intended use" language is not even in the preamble but after the preamble.

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257. The inquiry involves examination of the entire patent record to determine what invention the patentee intended to define and protect. See *Bell Communications*, 55 F.3d at 621 (looking to patent specification to determine whether claimed invention includes preamble recitations); *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (examining "patent as a whole"); *Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA*, 944 F.2d 870, 880, 20 USPQ2d 1045, 1053 (Fed. Cir. 1991) (looking to claims, specification, and drawings); *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 689, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (noting that preamble recitations provided antecedent basis for terms used in body of claim); *Corning Glass Works*, 868 F.2d at 1257 (considering the specification's statement of the problem with the prior art); *Kropa*, 187 F.2d at 152 (noting that preamble sets out distinct relationship among remaining claim elements). Inspection of the entire record in this case reveals that "angioplasty" is, in fact, a structural limitation of Rowe's claims. To begin with, the form of the claim itself, the so-called "Jepson" form, suggests the structural importance of the recitations found in the preamble. The Jepson form allows a patentee to use the preamble to recite "elements or steps of the claimed invention which are conventional or known." 37 C.F.R. 1.75(e) (1996). When this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope. See *Pentec, Inc. v. Graphic Controls, Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985) ("Although a preamble is impliedly admitted to be prior art when a Jepson claim is used, . . . the claimed invention consists of the preamble in combination with the improvement.") (citations omitted); *United States Patent and Trademark Office, Manual of Patent Examining Procedure* § 608.01(m) (6th ed. rev. Sept. 1995) ("[The Jepson form of claim] is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination."). Thus, the form of the claim itself indicates Rowe's intention to use the preamble to define, in part, the structural elements of his claimed invention. The device for which the patent claims "an improvement" is a "balloon angioplasty catheter."

There is no overlap in the claim coverage of claims 1-4, 6-8 of Rollat et al. (Patent No. 6,689,346), with applicant's claims 1-8, 10-13. The claims are mutually exclusive and define patentably distinct subject matter.

Claims 1-8, 10-13 stand rejected under 35 USC § 102(f), based on the assertion the applicant did not invent the claimed subject matter.

With respect to the rejection under 35 USC § 102(f), applicants did in fact invent the claimed subject matter. In support of this Applicant's submitted ROI N02835 showing the conception and reduction to practice of the claimed invention. This ROI was signed and witnessed electronically on August 2, 2000 and was obtained from 3M's corporate ROI database(attached previously was a copy of a screen print of the workflow entry of this ROI in the 3M Corporate ROI database which indicates that the ROI was witnessed exactly at 12:21:01 PM). This database is secure and not able to be altered.

Applicants are resubmitting a PDF copy of the screen print of the workflow entry of ROI N02835 in 3M's corporate ROI database, which is clearly legible, as well as PDF copies of ROI N028355 and a PDF copy of a web based version of applicants corporate ROI database showing the same witness date (August 2, 2000; 12:51 PM CDT) and witness (Kristen J. Godbey).

Respectfully submitted,

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Date

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